

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Stefan GALLINAT et al.

Confirmation No.: 3145

Application No. : 10/581,271

Group Art Unit: 1617

(National Stage of PCT/EP2004/013254)

Examiner: not yet assigned

I. A. Filed : November 22, 2004

For : COMBINATION OF 2,3-DIBENZYL BUTYROLACTONE AND
LICOCHALCONE-A

INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Amendment
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

Pursuant to 37 C.F.R. § 1.56 and 37 C.F.R. §§ 1.97-1.98, Applicants hereby direct the Examiner's attention to the following documents cited in the International Search Report for International Application PCT/EP2004/013254 of which the above-referenced application is a National Stage:

- (1) SHIBATA S. et al., "Inhibitory Effects of Licochalcone A isolated from *Glycyrrhiza Inflata* Root on Inflammatory Ear Edema and Tumor Promotion in Mice", *Planta Medica*, vol. 57, No. 3, 1991, pp. 221-224;
- (2) U.S. Patent No. 6,214,352 B1 (MATSUKAWA), April 10, 2001;
- (3) WO 03/070152 A2, August 28, 2003;
- (4) JP 2003-201214 A, July 18, 2003, accompanied by an English language abstract thereof (provided by Patent Abstracts of Japan);

- (5) English language abstract of KR 2002046615, June 21, 2002 (provided by WPI/Derwent);
- (6) WO 03/099244 A1, December 4, 2003;
- (7) U.S. Patent Application Publication No. 2006/0093633 A1 (STAB et al.), May 4, 2006; Applicants note that this document is a family member of document (6);
- (8) WO 03/101414 A1, December 11, 2003; Applicants note that this document is also cited in the German Search Report for German Application DE 103 57 451.4 of which the above-referenced application claims priority. This document is categorized in the German Search Report as X document, i.e. casting doubt on novelty or non-obviousness by itself;
- (9) U.S. Patent Application Publication No. 2005/0037042 A1 (TOM DIECK et al.), February 17, 2005; Applicants note that this document is a family member of document (8).

Applicants further direct the Examiner's attention to the following documents cited in the German Search Report for German Application DE 103 57 451.4 of which the present application claims priority:

- (10) U.S. Patent No. 5,609,875 (HADAS), March 11, 1997; this document is categorized in the German Search Report as Y document, i.e., casting doubt on non-obviousness in combination with other documents;

- (11) EP 0 998 939 A1, May 10, 2000; this document is categorized in the German Search Report as Y document, i.e., casting doubt on non-obviousness in combination with other documents;
- (12) WO 01/95923 A1, December 20, 2001; this document is categorized in the German Search Report as Y document, i.e., casting doubt on non-obviousness in combination with other documents;
- (13) U.S. Patent Application Publication No. 2002/0022665 A1 (ROSEN et al.), February 21, 2002; Applicants note that this document is a family member of document (12).

Applicants further direct the Examiner's attention to the following documents which are cited and discussed in the present application:

- (14) FROSCH P.J. et al. "A Method for Appraising the Stinging Capacity of Topically Applied Substances", Journal of the Society of Cosmetic Chemists, vol. 28, May 1997, pp. 197-209; Applicants note that this document is cited and discussed at page 7, line 1 of the present application;
- (15) DEFLANDRE A. et al. "Photostability Assessment of Sunscreens. Benzylidene Camphor and Dibenzoylmethane Derivatives", International Journal of Cosmetic Science, vol. 10, 1988, pp. 53-62; Applicants note that this document is cited and discussed at page 12, line 9 of the present application;

- (16) VOECKEL A. et al. "Vorkommen und Photo-Isomerisierung der Urocaninsäure im stratum corneum bei polymorpher Lichtdermatose (PLD). Vergleichende Untersuchung bei PLD-Patienten und Hautgesunden", Zentralblatt Haut, vol. 156, 1989, pp. 1-15; Applicants note that this document is cited and discussed at page 13, line 11 of the present application;
- (17) MIYACHI Y. "Skin Diseases Associated with Oxidative Injury" in "Oxidative Stress in Dermatology" edited by Jürgen Fuchs, Frankfurt and Lester Packer, Berkeley, Marcel Dekker Inc., New York, Basel, Hong Kong, pp. 323-331; Applicants note that this document is cited and discussed at page 13, line 19 of the present application;
- (18) U.S. Patent No. 4,144,325 (VOYT), March 13, 1979; Applicants note that this document is cited and discussed at page 13, line 29 of the present application;
- (19) U.S. Patent No. 4,248,861 (SCHUTT). February 3, 1981; Applicants note that this document is cited and discussed at page 13, line 29 of the present application;
- (20) DE 33 14 742 A1, October 25, 1984; Applicants note that this document is cited and discussed at page 27, line 21 of the present application;
- (21) U.S. Patent No. 4,514,231 (KERNER et al.), April 30, 1985; Applicants note that this document is a family member of document (20).

Furthermore, Applicants direct the Examiner's attention to the following copending and commonly assigned U.S. applications:

- (22) U.S. Patent Application Publication No. 2005/0158350 A1 (MAX et al.), July 21, 2005;
- (23) U.S. Patent Application Publication No. 2005/0186295 A1 (STAB et al.), August 25, 2005;
- (24) U.S. Patent Application Publication No. 2005/0201967 A1 (ALBRECHT et al.), September 15, 2005;
- (25) U.S. Application No. 10/571,530 to BLATT et al., filed March 10, 2006 (I.A. filed August 16, 2004) and entitled "USE OF LICOCHALCONE A OR OF AN EXTRACT CONTAINING LICOCHALCONE A FROM RADIX GLYCYRRHIZAE INFLATAE AGAINST SKIN AGING".

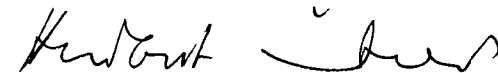
Copies of the above-listed documents (with the exception of U.S. patents and U.S. patent applications), the International Preliminary Report on Patentability (in English and German) for International Application PCT/EP2004/013254 and the German Search Report for German Application DE 103 57 451.4 are enclosed together with a completed copy of the Form PTO-1449 listing these documents (the International Search Report (in English and German) for International Application PCT/EP2004/013254 was filed on June 1, 2006). Accordingly, the Examiner is requested to consider these documents and to indicate such consideration by returning a signed and initialed copy of the Form PTO-1449 with the next official communication.

Further to 37 C.F.R. §1.98 (a)(2)(ii) and to the U.S. Patent and Trademark Office's decision to partially waive the requirement under 37 C.F.R. §1.98 (a)(2)(iii), copies of the U.S. patents and U.S. patent applications cited above are not enclosed herewith. However, if any copies are needed, the Examiner is respectfully requested to contact the undersigned.

Applicants note that an Office Action on the merits has not yet issued in the instant application, and thus, no fee is necessary to ensure consideration of this statement. However, if an Office Action has issued and is crossing in the mail with this statement, the Patent and Trademark Office is hereby authorized to charge Deposit Account No. 19-0089 any fee necessary to ensure consideration of the submitted materials.

Should there be any questions, the Examiner is invited to contact the undersigned at the telephone number listed below.

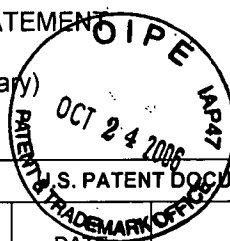
Respectfully submitted,
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FORM PTO-1449

Department of Commerce
Patent and Trademark OfficeAtty. Docket No.
P29848Application No.
10/581,271INFORMATION DISCLOSURE STATEMENT
BY APPLICANT
(Use several sheets if necessary)Applicant
Stefan GALLINAT et al.Filing Date
November 22, 2004Group
1617

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
		6 2 1 4 3 5 2	04/10/01	MATSUKAWA			
	2006	0 0 9 3 6 3 3	05/04/06	STAB et al.			
	2005	0 0 3 7 0 4 2	02/17/05	TOMDIECK et al.			
		5 6 0 9 8 7 5	03/11/97	HADAS			
	2002	0 0 2 2 6 6 5	02/21/02	ROSEN et al.			
		4 1 4 4 3 2 5	03/13/79	VOYT			
		4 2 4 8 8 6 1	02/03/81	SCHUTT			
		4 5 1 4 2 3 1	04/30/85	KERNER et al.			
	2005	0 1 5 8 3 5 0	07/21/05	MAX et al.			
	2005	0 1 8 6 2 9 5	08/25/05	STAB et al.			
	2005	0 2 0 1 9 6 7	09/15/05	ALBRECHT et al.			

FOREIGN PATENT DOCUMENTS

		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION YES NO
	03	/ 0 7 0 1 5 2	08/28/03	W.I.P.O			
	2003	- 2 0 1 2 1 4	07/18/03	JAPAN			
	03	/ 0 9 9 2 4 4	12/04/03	W.I.P.O			
	03	/ 1 0 1 4 1 4	12/11/03	W.I.P.O			
		0 9 9 8 9 3 9	05/10/00	E.P.O			
	01	/ 9 5 9 2 3	12/20/01	W.I.P.O			
		3 3 1 4 7 4 2	10/25/84	GERMANY			

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)

	1	SHIBATA S. et al., "Inhibitory Effects of Licochalcone A isolated from <i>Glycyrrhiza Inflata</i> Root on Inflammatory Ear Edema and Tumor Promotion in Mice", <i>Planta Medica</i> , vol. 57, No. 3, 1991, pp. 221-224.
	2	FROSCH P.J. et al. "A Method for Appraising the Stinging Capacity of Topically Applied Substances", <i>Journal of the Society of Cosmetic Chemists</i> , vol. 28, May 1997, pp. 197-209.
	3	DEFLANDRE A. et al. "Photostability Assessment of Sunscreens. Benzylidene Camphor and Dibenzoylmethane Derivatives", <i>International Journal of Cosmetic Science</i> , vol. 10, 1988, pp. 53-62.
	4	VOECKEL A. et al. "Vorkommen und Photo-Isomerisierung der Urocaninsäure im stratum corneum bei polymorpher Lichtdermatose (PLD). Vergleichende Untersuchung bei PLD-Patienten und Hautgesunden", <i>Zentralblatt Haut</i> , vol. 156, 1989, pp. 1-15.
	5	MIYACHI Y. "Skin Diseases Associated with Oxidative Injury" in "Oxidative Stress in Dermatology" edited by Jürgen Fuchs, Frankfurt and Lester Packer, Berkeley, Marcel Dekker Inc., New York, Basel, Hong Kong, pp. 323-331.

EXAMINER /Renee Claytor/

DATE CONSIDERED 03/02/2010


*EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /RC/

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U.S. PATENT DOCUMENTS

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FOREIGN PATENT DOCUMENTS

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OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)

6	U.S. Application No. 10/571,530 to BLATT et al., filed March 10, 2006 (I.A. filed August 16, 2004) and entitled "USE OF LICOCHALCONE A OR OF AN EXTRACT CONTAINING LICOCHALCONE A FROM RADIX GLYCYRRHIZAE INFLATAE AGAINST SKIN AGING".
7	English language Abstract of JP 2003-201214.
8	English language abstract of KR 2002046615, June 21, 2002 (provided by WPI/Derwent).

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